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10/685,970

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Dale W. Malik

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EXAMINER

CHANG, JUNGWON

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/685,970	<b>Applicant(s)</b> MALIK, DALE W.	
	<b>Examiner</b> Jungwon Chang	<b>Art Unit</b> 2154	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date 10/30/07, 12/20/07, 3/14/08
- 4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **FINAL ACTION**

1. This action is in response to amendment filed on 1/15/2008. Claims 1-16 are presented for examination.

2. The examiner objected the specification in the previous office action dated 10/17/2007. However, the applicant has not responded to the objection. Thus, the objection to the specification is maintained. The specification is objected to because the following informalities:

The cross-reference to related applications cited in page 1 of the specification has to be updated to include US Patent numbers or abandonment of applications.

3. The 35 U.S.C. 101 rejection to claims 11-16 is withdrawn in view of amendment.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coutts et al. (US 2003/0120805), hereinafter Coutts, in view of Srinivas et al, (US 7,249,161), hereinafter Srinivas.

6. As to claim 1, Coutts discloses a first communication device comprising:  
means for receiving an instant messaging (IM) message (214, fig. 2) from a sender directed to a first IM address (each IM user is inherently assigned a unique instant messaging address; page 3, 0027, "the originating device allows forwarding of messages"); and

means for conveying the IM message to a second IM address on a second communication device (each IM user is inherently assigned a unique instant messaging address; 228, fig. 2, "message forwarded to the available next user or device").

7. Coutts does not specifically disclose means for indicating to the second communication device that the message originated from the sender. However, Srinivas discloses means for indicating to the second communication device that the message originated from the sender (col. 5, lines 15-30). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Coutts and Srinivas because Srinivas' teaching would allow the recipient to be aware that where the message is coming from, as taught by Srinivas (col. 5, lines 15-30).

8. As to claim 2, it is rejected for the same reasons set forth in claim 1 above. In addition, Coutts discloses a first communication device comprising:

receive logic configured to receive, from a sender, an instant messaging (IM) message (214, fig. 2) directed to a first IM address (each IM user is inherently assigned

a unique instant messaging address; page 3, 0027, "the originating device allows forwarding of messages"); and

convey logic configured to convey the IM message to a second IM address on a second communication device (each IM user is inherently assigned a unique instant messaging address; 228, fig. 2, "message forwarded to the available next user or device").

9. As to claim 3, Coutts discloses wherein the convey logic is further configured to automatically convey the IM message to the second communication device (page 1, 0001, "automatically forwarding").

10. As to claim 4, it is rejected for the same reasons set forth in claim 1 above. In addition, Coutts discloses a communication method comprising:

receiving an instant messaging (IM) message at a first communication device, the IM message being intended for a recipient at a first IM address (204, fig. 2); and

conveying the IM message to a second IM address on a second communication device (228, fig. 2, "message forwarded to the available next user or device").

11. As to claim 5, Coutts discloses further comprising the step of: determining presence of the intended recipient at the second communication device prior to conveying the IM message to the second communication device (226, fig. 2, "next device available").

12. As to claim 11, it is rejected for the same reasons set forth in claim 1 above. In addition, Coutts discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (page 2, 0015, "memory for storage of applications and data; page 3, 0020, "client software stored by the client devices").

13. As to claim 12, it is rejected for the same reasons set forth in claim 5 above.

14. Claims 6-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. (US 6,539,421), hereinafter Appelman, in view of Srinivas et al, (US 7,249,161), hereinafter Srinivas.

15. As to claim 6, Appelman discloses a communication method comprising the steps of:

receiving an instant messaging (IM) message intended for a recipient, the recipient having IM addresses, the IM message including a designated IM address of the IM addresses for delivering the IM message (col. 3, lines 4-11, "receiving addresses of instant message recipients");

determining a presence of the recipient at each of the IM addresses (506, fig. 9; col. 5, line 43 – col. 6, line 7, "entries 502 for persons who are currently online, which is determined by checking the online status fields 506"); and

conveying the received IM message to the IM addresses at which the recipient is

present (col. 6, line 16 – col. 7, line 7; col. 8, lines 10-30; col. 14, lines 45-49, “potential instant message recipient is currently online”).

16. Appelman does not specifically disclose means for indicating to the second communication device that the message originated from the sender. However, Srinivas discloses means for indicating to the second communication device that the message originated from the sender (col. 5, lines 15-30). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Appelman and Srinivas because Srinivas' teaching would allow the recipient to aware where the message is coming from, as taught by Srinivas (col. 5, lines 15-30).

17. As to claim 7, is rejected for the same reasons set forth in claim 6 above. In addition, Appelman discloses a communication method comprising:

receiving an instant messaging (IM) message intended for a recipient, the recipient having IM addresses, the IM message including a designated IM address of the IM addresses for delivering the IM message (col. 3, lines 4-11, “receiving addresses of instant message recipients”);

determining a last active time for each of the IM addresses (508, fig. 9, “time stamp”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”);  
and

conveying the received IM message to the IM address having a most recent last active time (508, fig. 9, “time stamp”; col. 8, lines 10-30, “Barry was corresponded with

more recently than Bartholomew”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”)

18. As to claim 8, Appelman discloses further comprising: determining a presence of the recipient at each of the IM addresses prior to determining the last active time (506, fig. 9; col. 5, line 43 – col. 6, line 7, “entries 502 for persons who are currently online, which is determined by checking the online status fields 506”); and wherein determining the last active time comprises determining the last active time for each of the IM addresses at which the recipient is present (508, fig. 9, “time stamp”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”).

19. As to claim 9, Appelman discloses, wherein conveying the received IM message comprises: conveying the IM message to a most recent IM address at which the recipient is present, the most recent IM address being the IM address having the most recent last active time (508, fig. 9, “time stamp”; col. 8, lines 10-30, “Barry was corresponded with more recently than Bartholomew”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”).

20. As to claim 10, Appelman discloses further comprising: determining a presence of the recipient at each of the IM addresses (506, fig. 9; col. 5, line 43 – col. 6, line 7, “entries 502 for persons who are currently online, which is determined by checking the online status fields 506”); wherein conveying the received IM message comprises the



step of conveying the received IM message to the IM address at which the recipient is present (508, fig. 9, "time stamp"; col. 8, lines 10-30, "Barry was corresponded with more recently than Bartholomew"; col. 6, line 16 – col. 6, line 7, "the most recent time in its time stamp field 506").

21. As to claim 13, it is rejected for the same reasons set forth in claim 6 above. In addition, Appelman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

22. As to claim 14, it is rejected for the same reasons set forth in claim 7 above. In addition, Appelman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

23. As to claim 15, it is rejected for the same reasons set forth in claim 8 above. In addition, Appelman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

24. As to claim 16, it is rejected for the same reasons set forth in claim 9 above. In addition, Appelman discloses a computer-readable storage medium comprising:

computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

### ***Conclusion***

25. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 6:30-2:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jungwon Chang/  
Primary Examiner, Art Unit 2154  
April 8, 2008